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Remarks/Arguments

Claims 20-117 are currently pending in the application. Of these claims, 86-88 have been amended to correct the reference of each claim as requested by the Examiner. All pending claims are fully supported by the specification, and no new matter has been added to the application. For at least the reasons presented below, Applicant asserts that the pending claims are in condition for allowance.

1. Claim Objections to Claims 86-88

The Examiner objected to claims 86-88 because they depend on previously cancelled claim 85. As requested by the Examiner, Applicant has amended claims 86-88 such that the claims now depend upon claim 73. Applicant respectfully requests Examiner's objection be withdrawn.

2. 35 U.S.C. § 103 Rejections

Claims 20-117 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dworkin, U.S. Patent No. 4,992,940 (hereinafter "*Dworkin*"), in view of Dugan et al., U.S. Patent No. 6,363,411 B1 (hereinafter "*Dugan*"). Applicant respectfully opposes this rejection on the basis that *Dworkin* and *Dugan* separately or in combination fail to teach or disclose Applicant's claimed invention. On this basis it is respectfully submitted that the application is in order for allowance.

A. Applicant's Claims Are Allowable Because Neither *Dworkin* Nor *Dugan* Teaches or Discloses an Independent Framework Manager

Applicant amended the claims in the paper submitted December 10, 2003, in which Applicant emphasized in independent claims 20, 66, and 103 the existence of a framework manager independent of the first and second business entities using the network. *See*

Amendment and Response, Dec. 10, 2003, p. 4, 11, 19 (hereinafter "Response").[1] Applicant further distinguished *Dworkin* and the other prior art cited, McNamara et al., U.S. Patent No. 5,805,458 (hereinafter "*McNamara*"), from the presently claimed invention, partially on the basis that neither *Dworkin* nor *McNamara* disclose or teach the existence of an independent framework manager. Response, p. 25. The Examiner stated the feature claimed by Applicant, the Independent framework manager, was not claimed, and proceeded to reject Applicant's claimed invention based primarily on *Dworkin*. Applicant respectfully disagrees with the Examiner's act of not considering the limiting language in the preamble of independent claim 20, and respectfully requests withdrawal of the rejection based upon 35 U.S.C. § 103.

Claim 20 of Applicant's claimed invention is limited such that a framework manager acts independently of the first and second business entities using the network, thereby distinguishing Applicant's claimed invention from *Dworkin* and *Dugan*. *See* Claim 20. A claim preamble should be construed as if part of the balance of the claim if the claim preamble recites limitations of the claim. *See* MPEP § 2111.02 ¶ 2 (quoting *Pitney Boes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 U.S.P.Q.2d 1161 (Fed. Cir. 1999)). The Examiner's assertion that the limitation asserted by Applicant is not claimed is incorrect. *See* Office Action, p. 45. It is clear from the body of claim 20 that the preamble is essential to point out the claimed invention – an Independent framework manager. *See also Kropa v. Robie*, 187 F.2d 150, 152, 88 U.S.P.Q. 478 (C.C.P.A. 1951) (finding phrase of preamble was necessary to define the claimed invention, and was therefore considered part of the claims). Without considering the preamble of independent claim 20, the claim lacks

[1] Claims 66 and 103 are program and system claims, respectively, related to method claim 20. Arguments are made in regard to claim 20, but are equally applicable to claims 66 and 103.

"life, meaning, and vitality," and thus the preamble should be construed as part of the claim. *See Pitney Bowes*, 182 F.3d at 1305.

Evaluation of the Examiner's arguments reveals the Examiner has failed to address Applicant's invention described as a framework manager independent of the first and second business entities using the network. Applicant does not concede that *Dworkin* discloses two separate business entities using a network to transact business. Assuming *arguendo* that *Dworkin* discloses and teaches the use of a network by two different business entities in the transaction of business, *Dworkin* completely fails to disclose or teach the existence of any external framework manager that manages the framework used by the first and second business entitites. *See, e.g., Dworkin*, Fig. 1 (allegedly showing two separate business entities using the network, but referencing no separate entity managing the network).

The addition of *Dugan* fails to rectify the shortcomings of *Dworkin* because *Dugan*, like *Dworkin*, completely fails to disclose or teach the existence of a framework manager separate from the first and second business entities using the network. Furthermore, the Examiner fails to cite *Dugan* to support his rejection on the basis that *Dugan* teaches this element missing from *Dworkin*. *Dugan* is only cited, out of context, to refute other elements of the contested claims. *See, e.g.*, Office Action, p. 5-7 (applying *Dugan* to satisfy elements (c), (d), and (h) of claim 20).

Hence, the Examiner has failed to properly refute all elements of Applicant's claimed invention. "In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. MPEP § 2141.02 ¶ 2 (citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 U.S.P.Q 871 (Fed. Cir. 1983)) (emphasis removed). The Examiner has failed to consider the claimed invention as a whole, including the preamble, and has failed to cite relevant prior art that

would demonstrate Applicant's claimed invention is obvious. Therefore, rejection under 35 U.S.C. § 103(a) is inappropriate and Applicant respectfully requests withdrawal of the rejection. Applicant further submits that, as claimed, Applicant's invention is in condition for allowance.

B. *Dugan* is inapplicable to disclosing or teaching the present invention.

The Examiner argues that *Dugan* teaches elements (c) and (d) of claim 20. *See* Office Action, p.5-6. The Examiner further argues that *Dugan* addresses "supply and demand of products or services using the network." *Id.* Applicant respectfully disagrees.

Both sections cited by the Examiner are asserted out of context. The comparison element, allegedly disclosed in *Dugan* and cited by the Examiner, appears in the context of comparing data in a database with a database extract of data, not in the context of comparing services or products offered. *See Dugan*, col. 17, ll. 6-37. Likewise, the planning element, also allegedly disclosed in *Dugan*, appears in the context of removing a service component from a telecommunication service node, not in the context of projecting future service and product needs. *See id.* at Col. 24, ll. 33-37. The invention disclosed in *Dugan* bears no relation to Applicant's invention.

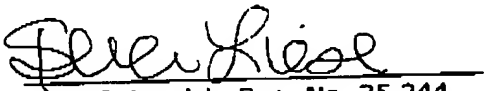
If such references made by the Examiner are considered in the context in which they are presented, it is apparent that *Dugan*, read to extend *Dworkin*, fails to teach the additional elements not addressed by *Dworkin*. An ordinary practitioner in the art would not recognize the combination of *Dworkin* and *Dugan* as obvious because *Dugan's* alleged discussion of supply and demand is not in the context of sales or the acquisition of products or services. Instead, *Dugan* addresses assigning services to specific telecommunications nodes in a closed telecommunications system, not modifying the system with additional products or services based upon the supply and demand of external providers. Therefore,

one of ordinary skill in the art would not combine *Dworkin* and *Dugan*, and rejection of Applicant's claims under 35 U.S.C. § 103(a) is inappropriate and should be withdrawn.

3. Conclusion

All rejections having been addressed, Applicant submits that all pending claims are in condition for allowance. Applicant respectfully requests reconsideration of the rejected claims and that a Notice of Allowance be issued in this case. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at 612-607-7000. If any fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees including fees for any extension of time, to Deposit Account No. 50-1901 (Docket 060021-335501).

Respectfully submitted,



Craig J. Lervick, Reg. No. 35,244
Steven Lieske, Reg. No. 47,749
Customer No. 29838

OPPENHEIMER WOLFF & DONNELLY LLP
Plaza VII, Suite 3300
45 South Seventh Street
Minneapolis, MN 55402
Phone: (612) 607-7000
Fax: (612) 607-7100

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